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RE: Appl. No.: 09/502,258
Applicant: Christoph Wuersch
Filed: Filed: February 11, 2000
Title: HEARING AID WITH MICROPHONE SYSTEM AND AN ANALOG/DIGITAL
CONVERTER MODULE

TC/AU : 2643
Docket No.: 32396

APR 11 2005

Appl. No. 09/502,258
Petition Dated April 11, 2005
In Response to Office action of February 9, 2005

PATENT**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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Title : HEARING AID WITH MICROPHONE SYSTEM AND AN
ANALOG/DIGITAL CONVERTER MODULE

Conf. No. : 4922
TC/AU : 2643
Examiner: : Suhan Ni

Docket No. : 32396
Customer No.: 00116

Mail Stop AF
Patent Technology Center 2600, Communications
Technology Center Director
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION REQUESTING WITHDRAWAL OF FINALITY OF OFFICE ACTION

Sir:

This petition is filed under 37 CFR 1.191 to the Technology Center Director of 2600, Communications, to request withdrawal of the finality of the Office action of February 9, 2005 for being premature.

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Robert F. Bodi
Name of Attorney for Applicant(s)

04/11/2005
Date

Signature of Attorney

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ARGUMENTS/REMARKS

This petition under 37 CFR 1.191 (see MPEP 1002.02(c)(3)(a)) is filed to request withdrawal of the finality of the Office action of February 9, 2005 for being premature. That Office action provided new grounds of rejection that the applicant disputes were necessitated by the claim amendments in the amendments filed on October 14, 2004.

Applicant notes that the 37 CFR 1.113 states that:

On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's...reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section.

The MPEP, in interpreting this rule, states that a final rejection is proper on a second action when

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a *new ground of rejection* that is neither *necessitated* by applicant's amendment of the claims nor based on information submitted in an information disclosure statement....

(MPEP § 706.07(a), emphasis added). The Examiner has rejected the claims on new grounds, and the Examiner has indicated that the new grounds of rejection were necessitated by applicant's amendment (see paragraph 5 of the Office action).

In the Office action of February 9, 2005, claims 1, 3, 6, 8-10, and 12-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Leedom (U.S. 6,389,143) *et al.* in view of Husung (U.S. 5,809,151), which was made final by the Examiner. In the prior Office action of March 24, 2004, claims 1 and 8-9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Carlson (U.S. 4,956,868). For the purposes of this analysis, we will look at claim 1 in detail.

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Claim 1 as before the Examiner at the time of issuance of the Office action of March 24, 2004, read as follows:

1. A hearing aid with a microphone system (1) and a subsequent analog/digital converter (5), wherein the microphone system (1) is encapsulated in an electromagnetic shielding case (3) forming a shielded microphone system unit and further wherein the analog/digital converter (5) is mounted on an outside of the electromagnetic shielding case (3).

In response to the Office action of March 24, 2004, applicant provided the following claim 1, amended as shown by the editing marks:

1. (currently amended) A hearing aid ~~with~~ comprising a microphone system ~~(1)~~ and a subsequent analog/digital converter ~~(5)~~, wherein the microphone system ~~(1)~~ is encapsulated in an electromagnetic shielding case ~~(3)~~ forming a shielded microphone system unit, and further wherein the analog/digital converter ~~(5)~~ is mounted on an ~~outside~~ outer surface of the electromagnetic shielding case ~~(3)~~.

Accordingly, except for the editorial changes of eliminating the reference numbers and replacing "with" with "comprising", the only other change to the claim was to replace the term "outside" with the term "outer surface". This change was done for clarification purposes. The new grounds of rejection were not necessitated by any of these amendments.

In the Office action of February 9, 2005, the Examiner states that the new grounds of rejection were "necessitated" by the amendments to the claims. The term "necessitated" is defined as "to make necessary. Require; 2 : Force, Compel" (see <http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=necessitate&x=16&y=20>). Accordingly, the Examiner is arguing that changing the term "outside" to "outer surface" *necessitated or compelled* the Examiner to find the new references

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and issue the new rejection. However, it is not reasonable to make such a determination for the following reasons:

In order to show that the amendment "necessitated" the new grounds and thus "compelled" the Examiner to issue the new rejections, the Examiner would have had to cite the new references against the amended claim language. Claim 1, as amended, recites that the "analog/digital converter is mounted on an outer surface of the electromagnetic shielding case". This claim limitation incorporates the change discussed above, i.e., using the term "outer surface" instead of the original term "outside". Thus, the new grounds of rejection must be directed at this amended claim language if the amendment had necessitated the new grounds of rejection.

But in rejecting this claim limitation, the Examiner admits that "neither Leedom *et al.* nor Husung teach an ADC as claimed", thus admitting that the new rejection is *not* related to the amendment and thus was not necessitated by the amendment. Instead, the Examiner argues that "providing any suitable signal processing components, such as an ADC, for a digital hearing aid is very well known in the art" and thus it "would have been obvious" to add the cited feature to the devices of the references. Accordingly, it is clear that the Examiner is not relying on the new references to reject the amended claim limitation.

Instead, the Examiner has essentially admitted that the new references were not required as a result of the amended claim language, because they were not cited against the amended claim language at all. Accordingly, the new references were not "necessitated", by the amendment and the Examiner was not compelled to issue the new rejection as a result of the amendment.

Summarizing the above discussion, the amendment to the cited claim 1 limitation clearly did not *necessitate* the new rejection, because the new references are not cited against the amended claim limitation. The Examiner was not forced to apply the new references to the claim by the amendment, because the new rejection is not applied to the amendment. Thus, there is no reasonable argument that the claim amendment in any way "necessitated" the new rejection, because there is no relationship between the amended claim limitation and the new references (note that

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neither reference has any teaching at all of an ADC). Accordingly, the Examiner is in no way relying on the new references to reject the amended claim limitation. Whether or not applicant had made the cited amendment would not impact whether or not the Examiner made the new rejection, because the new rejection of the amended limitation does not rely on the newly cited references. Accordingly, it is not possible that the amendment to claim 1 "necessitated" the finality of the action, and thus that finality is premature.

Furthermore, applicant notes that in the previous Office action of March 24, 2004, the Examiner also argued that putting an ADC on an "outside" of the shielding case was obvious, without relying on the reference teachings. Thus, in essence, in both the earlier and current Office actions, the Examiner is not relying on any of the references for making the rejection of the cited claim limitation, either as originally read or as amended. Thus, it is again clear that the claim amendment could not have *necessitated* the new grounds of rejection because the rejections in each of the Office actions for the cited claim limitations do not rely on any of the references at all, but instead appears to be a reliance on the skills of one in the art (because no reference is cited against the amended limitation). In essence, it is clear that the amendment of claim 1 has nothing at all to do with the newly cited references, and thus the finality of the rejection cannot be proper.

To simplify the argument, let's suppose that claim 1 is comprised of 4 limitations, A, B, C, and D. In the March 24 Office action, the Examiner cites a reference against elements A & B, but states that it would be "obvious" to add limitations C and D, without relying on the cited reference for any teaching. In response, applicant submits an amended claim 1 with amended limitation D' for clarification, but applicant argues that the rejection was improper because the Examiner had not found any teaching of limitations C or D or D'. In response, the Examiner cites new references against limitations A & B, but again argues that elements C and D' would be obvious to add, without relying on the new references. As is clear from this simplified discussion, the Examiner has not relied on the amendment to limitation D for the new rejections! Substitute the ADC for limitation C, and the limitation that the ADC be mounted on the outside/outer surface for limitation D/D', and you can see the validity of the above simplified argument.

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Accordingly, In consideration of the foregoing analysis, it is respectfully submitted that rejection of claim 1 in the Office action of February 9, 2005, is premature, and should be withdrawn according to MPEP 706.07(d). Similar arguments apply to the remaining rejected claims, but in any case should the finality of the rejection of claim 1 be improper, as argued above, then the finality of the Office action must be withdrawn.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32396.

Respectfully submitted,

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April 11, 2005